

In Re Application of: Hajime KIMURA

Serial No.: 09/837,105

Filed: April 18, 2001

For: Self-Light Emitting Device And  
Electrical Appliance Using The Same

Examiner: Dalei Dong

Art Unit: 2879

Confirm No.: 9007

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## **TABLE OF CONTENTS**

The Examiner Has Failed To Provide A Reason That Would Have Prompted One Skilled In The Art To Combine References .....	1
The Examiner Has Not Shown All The Claimed Elements.....	3
CONCLUSION.....	4

## **TABLE OF AUTHORITIES**

### **Cases**

<i>KSR Int'l Co. v. Teleflex, Inc.</i> , 127 S. Ct. 1727, 1741-1742, 82 USPQ 2d 1385 (2007).....	1, 2, 3
<i>In Re Fritch</i> , 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) .....	3
<i>In Re Oetiker</i> , 24 USPQ 2d 1443, 1444-1447 (Fed. Cir. 1992).....	3
<i>Bausch &amp; Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.</i> , 796 F.2d 443, 448, 230 USPQ 416, 419-420 (Fed. Cir. 1986).....	3

### **REPLY BRIEF UNDER 37 C.F.R. §41.41**

This Reply Brief is in response to the Examiner's Answer mailed August 17, 2007 and in furtherance of Appellant's Appeal Brief filed on May 11, 2007.

Initially, Appellant notes that pages 3-11 of the Examiner's Answer appear to merely repeat the Examiner's rejections from the Final Rejection. As Appellant has already responded to these rejections and arguments in its Appeal Brief of May 11, 2007, no further reply is necessary to these pages.

The Examiner's new arguments appear on pages 12-13 of the Answer, under the heading "Response to Argument." Appellant has the following reply to the Examiner's new arguments.

#### **The Examiner Has Failed To Provide A Reason That Would Have Prompted One Skilled In The Art To Combine References**

In his Answer, the Examiner appears to have entirely missed a major point in Appellant's brief and a requirement under the law. In particular, Appellant explained that under the law, in order to combine or modify references in an obviousness rejection, a reason must be provided that would have prompted one skilled in the art to combine the elements in the way the claimed invention does. See e.g. KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1741-1742, 82 USPQ 2d 1385 (2007). Appellant then explained in its brief why there is no reason for one skilled in the art to combine Ooi with Abe (e.g. Ooi is directed to a reflection device wherein the light scattering body in Ooi is intended to scatter and absorb light. As shown in Fig. 5 in Ooi, light from the substrate side is either reflected or absorbed, not extracted, while light from the opposite side (50G) from the substrate is let in, not extracted. This creates the bright display Ooi is trying to achieve. There is no reason for one skilled in the art to combine this teaching with Abe to arrive at the claimed display device of the

present application wherein for example the second surface of the light scattering body is for scattering and extracting a light).

In response, the Examiner states that:

“Ooi is not being combined with Abe for absorbing light, but to merely show that it is known in the art that a substrate may be in contact with a prism, both having first and second surfaces, an inner angle between the light scattering body and the second surface in the range of not less than 60 degrees and less than 180 degrees. Regarding Ooi not extracting light, the Examiner notes Ooi is not being used to show extraction or absorption of light. Abe clearly shows a light-scattering body that is used to extract light. Again, Ooi is merely used in combination with Abe to show inner angles and surfaces in contact with each other, not for extraction of [sic or] absorption.”

Hence, the Examiner has not provided a reason that would have prompted one skilled in the art to combine Ooi and Abe in the way the claimed invention does. Instead, the Examiner is merely combining Ooi with Abe because Ooi allegedly discloses one of the claimed elements. Hence, the Examiner is using the claim and its elements as his basis for combining references and picking and choosing disclosures in the references to arrive at the claimed invention. This is not a reason as provided for in KSR. A rejection cannot be sustained based on mere conclusory statements, as in the present case. KSR, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385 (2007). There must be some articulated reasoning supporting the legal conclusion of obviousness. Id. As KSR stated, a reason that would have prompted one skilled in the art to combine the references is needed “because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” Id.

Instead, what the Examiner has done is clear hindsight reconstruction, using the claim as a blue print for finding and combining references. Such hindsight reconstruction is improper, and any rejection based thereon improper. See e.g. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); In re Oetiker, 24 USPQ 2d 1443, 1444-1447 (Fed. Cir. 1992); KSR, 127 S. Ct. 1727, 1742, 82 USPQ 2d 1385 (2007).

Further, the Examiner appears to be clearly disregarding the teachings in Ooi (which are clearly directed to light absorption and not light extraction) as the Examiner states that “Ooi is not being used to show extraction or absorption of light.” While the Examiner is not using Ooi to show extraction or absorption of light, the Examiner cannot ignore the fact that Ooi teaches light absorption and not light extraction as in the claimed invention. To consider less than the entire teaching is to engage in improper hindsight reconstruction. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416, 419-420 (Fed. Cir. 1986).

The Examiner should have considered the entire teaching in the reference and then provided a reason (other than the claim element itself or mere conclusory statements) that would have prompted one skilled in the art to combine references. The Examiner has not done this, and therefore, the §103 obviousness rejections are improper and should be reversed.

#### **The Examiner Has Not Shown All The Claimed Elements**

On page 13 of the Answer, the Examiner argues that Abe discloses that the prismatic film may be formed of two layers, not one (citing to col. 4, lines 20-24 in Abe) and contends that since two layers of the prismatic film can be present in Abe, an inner angle would obviously be present between the two surfaces of the two layers. However, even if this were true (which Appellant does

not admit), the Examiner has still failed to make a prima facie case and has failed to show all of the claimed elements.

For example, the pending claims of the present application recite an inner angle between the first surface of the light scattering body and the second surface of the light scattering body and that the second surface of the light scattering body is for scattering and extracting light. The claims also recite a light scattering body having a first surface and a second surface, formed on a second surface of the substrate, which is opposite to the first surface of the substrate (a first electrode formed on the first surface of the substrate, with an EL layer and a second electrode over the first electrode). Further, an inner angle between the first surface of the light scattering body and the second surface of the light scattering body is not less than 60° and is less than 180°.

As the Examiner admits, Abe does not disclose an inner angle between the first surface of the light scattering body and the second surface of the light scattering body is not less than 60° and is less than 180°. As explained above, the combination of references is improper. Hence, the Examiner cannot rely upon Ooi to show this claimed feature. Therefore, the Examiner has failed to show all of the claimed elements and has failed to make a prima facie case of obviousness.

Accordingly, the §103 obviousness rejections should be reversed.

## **CONCLUSION**

For at least the reasons stated above, Appellant earnestly and respectfully submits that the rejections under 35 USC §103(a) of the claims of the present application are erroneous and improper.

Hence, the rejections of the claims should be reversed, and the claims allowed.

Accordingly, Appellant requests that this Appeal be sustained in all respects, and that all rejections in the Final Rejection be reversed.

Respectfully submitted,

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